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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,973	05/30/2001	Ronald Paul Rohrbach	H0001202	8302

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EXAMINER

CINTINS, IVARS C

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/867,973	ROHRBACH ET AL.	
	Examiner	Art Unit	
	Ivars C. Cintins	1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The term "the basic salt (claim 2, line 1) lacks antecedent basis in the claims, and is therefore indefinite. Also, the term "racially" (claim 4, line 3) appears to be a typographical error which renders this claim indefinite. Applicant is advised that an amendment changing "racially" to "radially" in line 3 of claim 4 would overcome this portion of the rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-10, 13-15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brownawell et al. (U.S. Patent No. 5,069,799; hereinafter "Brownawell '799"). Brownawell '799 discloses an oil filter comprising a hollow housing having an inlet and an outlet, a mechanically active filter member (i.e. "inactive filter media" 12) disposed inside the housing, and a chemically active filter member (i.e. 14) disposed inside this housing. This reference further discloses an embodiment (see Fig. 2) having a supplemental cartridge with a chemically active filter member (i.e. 30) disposed therein. The chemically active filter member includes a plurality of particles (see col. 2, line 6) containing a beneficial additive such as a basic salt of the type recited (see col. 2, lines 12-17). Accordingly, this reference discloses the claimed invention with the exception of the diameter of the particles in the chemically active filter

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member (claims 1, 2, 5-10, 13-15, 17), and the percentage of additive in these particles (claim 18). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ particles having the recited diameter in the reference system, in order to facilitate handling of the treatment material in this reference system. Also, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the recited amount of beneficial additive in the reference particles, in order to ensure that a sufficient amount of additive is present in these particles to adequately rejuvenate the oil undergoing treatment.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brownawell '799 as applied above, and further in view of DeJovine (U.S. Patent No. 4,144,166). Brownawell '799 as modified above discloses the claimed invention with the exception of the recited polymeric binder. DeJovine discloses a similar oil filter, and teaches supporting an oil additive material such as calcium carbonate or calcium hydroxide (see col. 11, lines 57-58) with a polymeric material of the type recited (see col. 3, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the polyolefin of DeJovine as the "polymer matrix" of Brownawell '799 (see col. 2, line 2), since this polyolefin is capable of supporting the calcium carbonate or calcium hydroxide of this primary reference (see col. 2, lines 12-13) in the required manner.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brownawell '799 as applied above, and further in view of Bilski et al. (U.S. Patent No. 5,725,031). Brownawell '799 as modified above discloses the claimed invention with the exception of the recited location of the chemically active filter element with respect to the mechanically active filter element.

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Bilski et al. discloses a similar oil filter containing both a mechanically active filter element and means for adding a chemical to oil undergoing treatment, and further discloses (see Fig. 1) locating the chemical adding element radially and coaxially inside the mechanically active filter element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the chemically active filter element (i.e. 14) of Brownawell '799 inside the mechanically active filter element (i.e. 12), as suggested by Bilski et al, in order to produce a more compact filtration and treatment device.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brownawell '799 as applied above, and further in view of Robers et al. (U.S. Patent No. 5,544,699). Brownawell '799 as modified above discloses the claimed invention with the exception of the recited auxiliary inlet and outlet tubes. Robers et al. discloses an oil filter having auxiliary inlet and outlet tubes (42 and 44), in order to cool the oil in the system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of the modified primary reference with the cooling arrangement of Robers et al., in order to obtain the advantages disclosed by this secondary reference for the system of the modified primary reference.

Brown (U.S. Patent No. 5,948,248) and Martin et al. (U.S. Patent No. 6,238,554) disclose similar devices for both filtering and adding a chemical to a fluid.

Applicant's arguments filed December 15, 2004 have been noted and carefully considered but no longer appear to be relevant in view of the new grounds of rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (571) 272-1155. The

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examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Duane Smith, can be reached at (571) 272-1166.

The centralized facsimile number for the USPTO is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
February 28, 2005